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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,102	03/16/2001	Eli Nhaiissi	NETEX-P3-US	3034
44702 7590 03/12/2010 OSTRAGER CHONG FLAHERTY & BROITMAN PC 570 LEXINGTON AVENUE FLOOR 17 NEW YORK, NY 10022-6894				
EXAMINER AKINTOLA, OLABODE				
ART UNIT		PAPER NUMBER		
3691				
NOTIFICATION DATE		DELIVERY MODE		
03/12/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

09/744,102

**Applicant(s)**

NHAISSI ET AL.

**Examiner**

OLABODE AKINTOLA

**Art Unit**

3691

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 194-199 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 194-199 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 7/20/2009
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 194-195 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roden (US 5970477) in view of Toader et al (US 5749075) in view of Ferguson et al (US 5819092).

Re claim 194: Roden teaches a method of Internet billing, comprising: enabling a user computer to access a plurality of Internet sites each of which is a provider of a product or service for purchase by a user via said cost server at which the respective user has established a *user account* (fig. 1 RN {24, 18, 22}, col. 7, line 65 through col. 8, line 40, col. 9, lines 33-40); tracking access of the user to each said Internet product provider site and obtaining information as to a value amount said user requests to purchase at each said

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Internet product site (col. 11, lines 52-54, col. 9, lines 33-40, col. 13, lines 3-49); and generating a debit against an amount of the user account established at the cost server according to the value amount information obtained in said tracking, (col. 8, lines 60-63, col. 9, lines 23-49, col. 13, lines 3-49 “allocation parameters” and “distance-based rates”).

Roden does not explicitly teach the use of pre-paid user account in a given authorized amount; tracking the characteristics of the user's response to at least one activity the user performs on the website, wherein the generating of a debit includes modifying the debit by an award credit which is variable based on said tracking of the characteristics of the user's response to the at least one activity performed by the user on said Internet provider site.

Toader teaches the use of pre-paid user account in a given authorized amount (abstract, col. 3, lines 48-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Roden to include prepaid accounts for the obvious reason of limiting the access time and/or cost of products desired by the user to the balance available in the prepaid account.

Fergusson teaches the concept of tracking characteristics of a user's response to certain actions such as filling out a marketing questionnaire or winning a contest (*equivalent to at least one activity the user performs on the website*), wherein generating a debit includes modifying the debit by an award credit which is variable based on the tracking of the user's response to said actions (see at least col. 4, lines 33-62, col. 9, lines 12-20, col. 10, lines 1-11, col. 12, lines 14-23, col. 29, lines 44-55, col. 30, lines 20-58, 60-67). It would have been obvious to one of ordinary skill in the art at the time of the invention

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to modify Roden to include these features as taught by Ferguson for the obvious reason of offering an incentive to the user for participating in the activities.

Re claim 195: Roden, Toader and Ferguson are as discussed in claim 194.

Toader/Ferguson further teaches the concept of crediting the account of the user responsive to the user activity (Ferguson: col. 30, lines 20-58, 60-67; Toader: col. 3, lines 48-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Roden to this feature for the obvious reason of offering an incentive to the user for participating in the activities.

Claims 196-199 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roden in view of Toader in view of Ferguson as applied to claim 194, and further in view of EM Report ("New Service Rewards Users For Viewing Web Ads", June 18, 1996) (hereinafter referred to as "EMR") .

Re claim 196: Roden, Toader and Ferguson are as discussed in claim 195.

Roden, Toader and Ferguson do not explicitly teach wherein the user activity comprises at least one of supplying personal user information, exposure to advertisement, responding to an advertisement, initiating an advertisement or viewing an advertisement. EMR teaches the concept of rewarding a user with bonus points responsive to user viewing ads or filling out questionnaires (page 1, paragraphs 1-10). Therefore, it would have been obvious to one of ordinary skill in the art to modify Roden in view of Toader

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in view of Ferguson with this feature as taught by EMR for the obvious reason of offering an incentive to the user for participating in the activities.

Re claims 197-198: Roden, Toader, Ferguson and EMR are as discussed in claim 196. Toader/EMR further teaches the wherein the bonus points are awarded based on a specific expenditure by the user, wherein the expenditure is at least of using a service, receiving a gift or responding to information (Toader: col. 3, lines 48-58; EMR: page 1, paragraphs 1-10). Therefore, it would have been obvious to one of ordinary skill in the art to modify Roden with this feature as taught by Toader/EMR for the obvious reason of offering an incentive to the user for participating in the activities.

Re claim 199: Roden, Toader, Ferguson and EMR are as discussed in claim 197. Toader further teaches wherein the bonus points are used for at least one of an extra service, increased access functionality, increased quality of service or increased amount of service (col. 3, lines 48-58). Therefore, it would have been obvious to one of ordinary skill in the art to modify Roden with this feature as taught by Toader for the obvious reason of offering an incentive to the user for participating in the activities.

### ***Response to Arguments***

Applicant's arguments filed December 5, 2009 have been fully considered but they are not persuasive.

Applicant argues that Ferguson fails to teach modifying the amount to the user's account with an awarded credit which is a variable based on characteristics of the user's

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responding to one or more activities performed by the user on the website. Examiner respectfully disagrees. Applicant referred Examiner to Page 22, line 12 through page 24, line 5, and particularly at page 22, lines 23-28 of the instant specification as showing support for this limitation. Examiner however notes that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Given the broadest reasonable interpretation of the claim, “the characteristics of the user’s response” is simply interpreted as whether or not the user participates in the activity. One characteristic of a user’s response is a user who does not participate or respond to the activity (such as filling out a survey) and is therefore awarded no point. Another characteristic of a user’s response is a user actively participating in the activity and is therefore awarded the bonus point. Ferguson teaches this concept at col. 4, lines 33-6 and col. 30, lines 20-58, 60-67.

### ***Conclusion***

Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/

Examiner, Art Unit 3691



